

nyb



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,146	07/28/2000	Nicolas Javier Di Prinzio	102	3537

22197 7590 12/01/2003

GENE SCOTT; PATENT LAW & VENTURE GROUP  
3140 RED HILL AVENUE  
SUITE 150  
COSTA MESA, CA 92626-3440

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/01/2003

37

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/628,146

Applicant(s)

DI PRINZIO, NICOLAS JAVIER

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-14, 17, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-14, 17, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3722

## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Response to Amendment***

1. Claims 2-17 have been amended. Claims 1, 15, 16 and 22 have been canceled. The previous allowable subject matter in claims 20 and 21 have been withdrawn.

Art Unit: 3722

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations: of the “pair of wall members..overlapping one another” as stated in Claim 4, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-14, 17, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In Claim 4, it is not understood how the “pair of wall members are overlapping one another”. Does the applicant mean to say that “one wall member overlaps the other”?

Art Unit: 3722

4. Claim 6 recites the limitation "the overlapping base and clip portion" in line 3. There is insufficient antecedent basis for this limitation in the claim. Does applicant mean to claim "the overlapping base portion and the clip portion"?

5. In Claim 20 and 21, it is not understood what is meant by "a normally closed orientation" as stated in line 4. Does this mean that claimed invention returns to an original shape after it has been deformed? It is also not understood how there can be "contact between the magnetic members" when the cover member along the interior surface is covering and separating the magnetic members.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, 7-12, 20 and 21, as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Berglof et al (5,682,653).

Berglof et al discloses in Fig. 1 and 2, a magnetic clip marker comprising: magnetic members (11, which have two on each side) each having a thickness; a pair of wall members (18A

Art Unit: 3722

and 19A) of unequal length (Col. 3, lines 10-13) aligned (Col. 3, lines 20-23) at a throat (interior side of 13A in Fig. 1) to define a structure exhibiting normally closed orientation (due to the magnets constant attraction) with opposite surfaces (18B and 19B) providing a continuous interior surface extending between the throat and terminal ends (A and B) of the wall members; with the wall members comprised of a base portion (19) adjacent terminal ends (A), and a clip portion (18) overlapping the base portion to define the throat ( between the wall members) as a junction and structurally arranged to receive insertion of a page/sheet between the clip portion and the base portion until the edge of page/sheet engages the throat; wherein the wall members are transverse to the junction; the wall members supporting the magnetic members along the interior surface; a plastic cover member (C) disposed along the interior surface to form a continuous layer extending from a first terminal end (A), around the throat, to a second terminal end while covering and separating the magnetic members.

However, Berglof et al does not disclose: wherein the pair of wall members define an integral structure; the throat as a junction between the wall members; and wherein the clip and base portions are arranged to receive insertion of a page of a book; wherein the cover member is made of cellulosic material and wherein the wall members are circular.

In regards to Claim 4, it would have been an obvious matter of design choice to make the wall members of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Therefore, the wall members of the

Art Unit: 3722

Berglof et al reference are capable of being circular depending upon magnet layout and shape of plastic wrap.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cover member in any desirable material such as cellulose, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Since applicant has not disclosed the criticality of the use of cellulose material in the cover member, the cover member can be constructed of any desired material.

In regards to **Claims 20 and 21**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the marker as an integral structure, and wherein the throat is a junction (joining of two separate pieces), since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Therefore, the wall members and throat of the Berglof et al reference would continue to function the same if they had been constructed integrally.

In regards to **Claims 11 and 20**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

Art Unit: 3722

the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the throat of the Berglof et al reference is capable of receiving the insertion of any desired sheet substrate between the wall members, cover member and magnets. The wall members of the Berglof et al reference is also capable of forming into a signaling member.

7. Claims 2 and 3, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Berglof et al in view of Holtz (4,255,837).

Berglof et al discloses a clip marker having all the elements as set forth in Claim 21 and as set forth above. However, Berglof et al does not disclose wherein at least one external surface of clip marker opposite an opening of the throat provides an application surface for graphic prints and a signaling tab member.

Holtz discloses in Fig. 12 and 13, a clip marker comprising an external surface (3A) opposite an opening (A) of the throat (B) provides an application surface (surface that is connected with tab member (19)) for graphic prints (19A).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berglof et al's marker with graphic print applied to the external surface of the marker as taught by Holtz for the purpose of displaying information pertaining to the page held.



Art Unit: 3722

8. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berglof et al in view Johnson.

Berglof et al discloses a clip marker having all the elements as set forth in Claim 21 and as set forth above. However, Berglof et al does not disclose at least one of the base or clip portion including an opening of ornamental design form.

Johnson discloses in Fig. 1 and 3, a clip marker having an opening (12) of an ornamental form to provide a line identification.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berglof et al's clip marker to include an opening as taught by Johnson for the purpose of defining an index member associated with the opening.

In regards to **Claim 13**, a recitation of the intended use ("to provide a line identification on the page") of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Art Unit: 3722

***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Bialczyk et al, Ogg et al, Smith, Smith ('649), McNeely disclose magnetic clip markers.

***Allowable Subject Matter***

9. Claims 6 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


***Response to Arguments***

10. Applicant's arguments with respect to claims 2-14, 17, 20 and 21 have been considered but are moot in view of the new ground(s) of rejection. The Berglof et al reference has now been used to further reject the claims.

Art Unit: 3722


**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 21, 2003



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700